

REMARKS

I. Introduction

With the cancellation of claim 23, without prejudice, claims 10 to 22, and 24 are currently pending in the present application. In view of the foregoing amendments and the following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

Applicants thank the Examiner for considering the Information Disclosure Statement, PTO-1449 paper, and cited references filed October 17, 2006.

II. Interview Summary

Applicants thank the Examiners for the courtesies extended during the telephone interview of January 25, 2007 among Examiner Khuu, Examiner Nghiem, Clifford A. Ulrich (Reg. No. 42,194), and Aaron Grunberger (Reg. No. 59,210).

The following is a Statement of Substance of Interview of the telephone interview of January 25, 2007.

During the course of the telephone interview, no exhibit was shown and no demonstration was conducted.

During the course of the telephone interview, Applicants' representatives noted that the Examiner has failed to establish that lack of unity of invention requirement has been properly established since the Office has not identified any prior art considered with respect to any of the claims, has not indicated which features of the claims distinguish the claims over the prior art, and has not indicated whether a determination has been made that the claims of Group I (claims 10-14 and 22) and Group II (claims 15-21) do not share any special technical feature that distinguishes the claims over the prior art. Examiner Khuu indicated that the determination of lack of unity of invention would be reconsidered based on these arguments.

During the course of the telephone interview, the rejection in the Final Office Action of December 29, 2006 of claims 15 to 21 under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter on the basis that "the practical application of the claimed invention cannot be realized until the information determined is conveyed to the user" was discussed. M.P.E.P. § 2106(IV)(C)(2)(b) was referenced by the Examiners as supporting the position stated in the Final Office Action. Applicants' representatives explained that there is no requirement for determined information to be conveyed to a user in order for the claim to be considered to have practical application and that M.P.E.P. §

2106(IV)(C)(2)(b) in no manner supports the Final Office Action's position in this regard. Further, Applicants' representatives explained that claims 15 to 21 recite steps that provide for physical transformations, and that based on such steps alone the claims are considered to provide a practical application. Further, Applicants' representatives explained that the claims do not merely recite steps that correspond to an abstract idea, but rather recite a method having the practical application of "testing a measuring system for correct functioning." Examiner Khuu indicated that the position stated in the Final Office Action would be maintained but that a panel would be consulted to determine the correctness of the position that claims 15 to 21 do not satisfy the requirement of 35 U.S.C. § 101.

During the course of the telephone interview, Examiner Khuu indicated that claim 23 would overcome the 35 U.S.C. § 101 if amended to recite "outputting a test data result conditional upon a determination that the change has not been effected."

The general result or outcome of the telephone interview is that no agreement was reached regarding the unity of invention requirement or 35 U.S.C. § 101 rejections of the presently pending claims.

III. Unity of Invention

Applicants respectfully maintain that the Office Actions to date plainly fail to establish that the unity of invention requirement has not been satisfied. As an initial matter, whether a method according to claims 15 to 21 requires a control element as recited in claims 10 to 14 and 22 and whether the method can be practiced with the measuring system as recited in claims 10 to 14 and 22 are entirely irrelevant to the question of whether the unity of invention requirement is satisfied. In addition, the classification of the groups of claims and examining art units is also entirely irrelevant to the question of whether the unity of invention requirement is satisfied.

Unity of invention exists when there is a technical relationship among the claims involving one or more of the same or corresponding special technical features, *i.e.*, those technical features that define a contribution which each of the inventions, considered as a whole, makes over the prior art. As set forth above, there is no mention whatsoever in any Office Action to date that any consideration has been given to whether Group I, *i.e.*, claims 10 to 14 and 22, and Group II, *i.e.*, claims 15 to 21, involve one or more of the same or corresponding special technical features. Indeed, no comparison has apparently been made at all to the prior art. In this regard, the only ground of rejection raised to date is a rejection of claims 15 to 21 under 35 U.S.C. § 101, which is addressed below.

In view of the foregoing, reconsideration and withdrawal of the finding of a lack of unity of invention is respectfully requested. In any event, it is believed and respectfully submitted that rejoinder will be appropriate when claims 15 to 22, and 24 are found allowable.

IV. Rejection of Claims 15 to 21 Under 35 U.S.C. § 101

Claims 15 to 21 were rejected under 35 U.S.C. § 101 as allegedly directed to non-statutory subject matter.

While Applicants do not agree with the merits of the present rejection, to facilitate matters, claim 15 has been amended herein without prejudice to recite "outputting test data conditional upon a determination that the change has not been effected." As noted above, during the course of the telephone interview conducted on January 25, 2007, the Examiners indicated that such an amendment would overcome the present rejection.

Withdrawal of this rejection is therefore respectfully requested.

V. Conclusion

In light of the foregoing, it is respectfully submitted that all of the presently pending claims are in condition for allowance. Prompt reconsideration and allowance of the present application are therefore earnestly solicited.

Respectfully submitted,

Dated: APR 27, 2007 By: Clifford A. Ulrich
Clifford A. Ulrich
Reg. No. 42,194

KENYON & KENYON LLP
One Broadway
New York, New York 10004
(212) 425-7200
CUSTOMER NO 26646